

REMARKS

This amendment is responsive to the Office Action dated November 25, 2008, and received in this application. Claims 12 and 23 have been amended only to correct typographical errors. New claims 39 and 40 have been added. *No new matter has been added.* Support for new claims may be found variously throughout the Specification, for example in paragraphs [0112] - [0123]. Claims 12 and 20-40 remain pending in the application. Reconsideration and allowance of the pending claims is respectfully requested.

Claims 12 and 20-38 have been rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 6,689,458 to Mikoshiba ‘458 et al (“Mikoshiba ‘458”) and U.S. Patent No. 6,411,344 to Fujii et al (“Fujii”) in view of U.S. Patent No. 6,025,958 to Yamaoka et al (“Yamaoka”). This rejection is respectfully traversed.

Independent claim 12 recites: *[a] transparent conductive laminate comprising:*

a film made of a polymer with a photoelastic constant of no greater than $70 \times 10^{12} \text{ Pa}^{-1}$ (polymer film A),

a light-scattering layer with a haze value in the range of 0.2-1.4% formed directly on one side thereof, and

a transparent conductive layer formed on the other side thereof, wherein the laminate exhibits a $\lambda/4$ retardation,

wherein an optical interference layer comprising a high refractive index layer and a low refractive index layer is formed between said polymer film A and said transparent conductive layer so that said transparent conductive layer is in contact with the low refractive index layer side, and the high refractive index layer and low refractive index layer are both made of crosslinked polymers.

The combined references, Mikoshiba ‘458, Fujii, and Yamaoka, either alone or in any permissible combination, fail to disclose or suggest these features.

Mikoshiba ‘458 discloses a transparent conductive laminate including a polarizer 10, a cross-linked polymer layer 5, a polycarbonate film 4, a cross-linked polymer layer containing fine

particles 6, and a transparent conductive layer 8. (Mikoshiba '458, col. 5, lines 25-37; FIG. 2.) As shown in Mikoshiba '458 FIG. 2 (reference characters labeled from specification), shown below-right, Mikoshiba '458 discloses a cross-linked polymer layer containing fine particles 6 on the same side of the polycarbonate film 4 as the transparent conductive layer 8.

Fig. 2

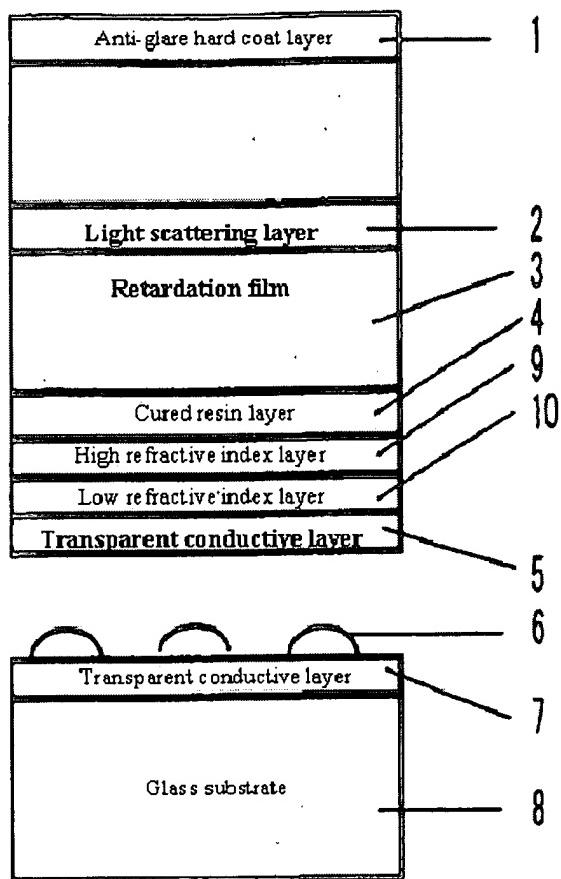
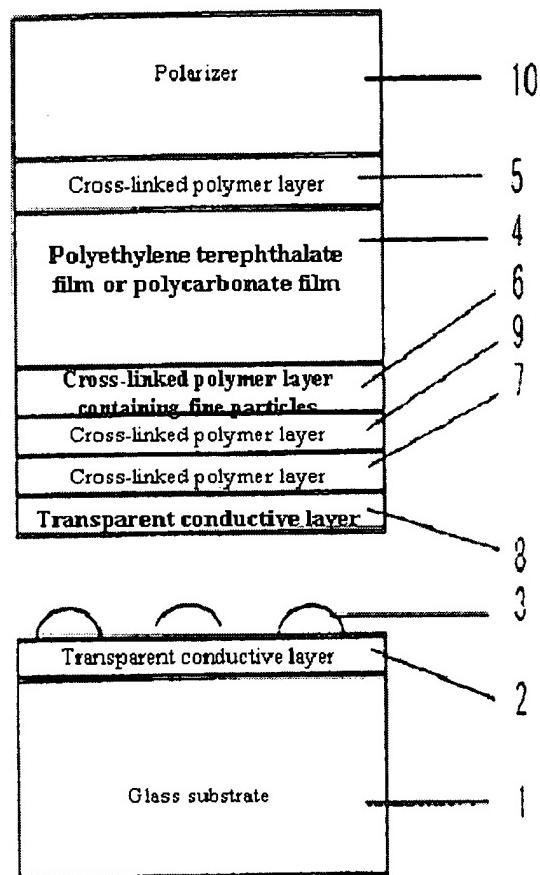


FIG. 2



APPLICANT

Above-left, Applicant's FIG. 2 (reference characters labeled from specification) is shown in contrast with Mikoshiba '458 FIG. 2 (reference characters labeled from specification), above-right. Applicant's FIG. 2 (reference characters labeled from specification) in no way is intended to limit

MIKOSHIBA

the scope of claim 12, but is only given to aid in understating the structural relationships between the various layers recited in claim 12.

It is clear, therefore, when contrasting that which is disclosed by Mikoshiba '458 and that which is recited in claim 12, that Mikoshiba '458 clearly fails to disclose:

"a film made of a polymer with a photoelastic constant of no greater than $70 \times 10^{-12} \text{ Pa}^{-1}$ (polymer film A),

a light-scattering layer with a haze value in the range of 0.2-1.4% formed directly on one side thereof, and

a transparent conductive layer formed on the other side thereof, wherein the laminate exhibits a $\lambda/4$ retardation[.]"

This difference in structure is significant and should not be disregarded. As disclosed in Applicant's Specification:

[I]t has been found that lack of a protective layer on a side opposite to the transparent conductive layer-formed side of the retardation film can sometimes create problems during actual manufacturing, such as scratching of the retardation film during the process of forming the transparent conductive layer or the processes of making up the touch panel, or can lead to insufficient reliability of adhesion when the retardation film is attached to the polarizing plate. (Specification, para. [0006].)

Applicant's Specification further discloses:

The light-scattering layer has the function of scattering light, but it may also sometimes function to enhance the cohesion between the polymer film A and the polymer film B or the polymer film A and the polarizing plate, or to act as a layer with the function of preventing scratches of the polymer film A during manufacturing process of the transparent conductive laminate. (Specification, para. [0088].)

Yamaoka is relied upon in the Office Action, but Yamaoka fails to remedy the deficiencies of Mikoshiba '458. Yamaoka discloses a laminated wavelength plate having "a plurality of oriented films of oriented films giving a retardation having a wavelength half that of monochromatic light laminated with their optical axes crossing each other, wherein the dependence of the birefringence differences Δn_1 and Δn_2 of the oriented films on wavelength each satisfy the relationship $\Delta n_1 / \Delta n_2$

<1.05 based on light having wavelength of 400 nm (Δn_1) and 550 nm (Δn_2).” (Yamaoka, col. 3, lines 11-18.)

However, Yamaoka, like Mikoshiba ‘458, fails to disclose:

“*a film made of a polymer with a photoelastic constant of no greater than $70 \times 10^{-12} Pa^{-1}$ (polymer film A),*

a light-scattering layer with a haze value in the range of 0.2-1.4% formed directly on one side thereof, and

a transparent conductive layer formed on the other side thereof, wherein the laminate exhibits a $\lambda/4$ retardation[.]”

Finally, in the Office Action, Fujii is relied upon, but Fujii fails to remedy the deficiencies of Mikoshiba ‘458 and Yamaoka. Fujii discloses a transparent touch panel having a pair of transparent conductive substrates and a retardation film. (Fujii, col. 2, lines 28-47.)

Further, Fujii discloses a polycarbonate film with an epoxy acrylic coating solution having particle fillers coated on one side. (Fujii, col. 11, lines 14-21; FIG. 5.) After the epoxy film is cured to form a hard coat layer, a conductive ITO film is formed on the hard coat layer by a sputtering method “so as to prepare a retardation film having a transparent conductive layer.” Fujii, discloses that the laminate consisting of the retardation film 12, the hard coat layer, and the transparent conductive ITO film 16 has a haze value of 0.8%.

As shown in Fujii FIG. 5 (reference characters labeled from specification), below-right, Fujii discloses a hard coat layer of a cured resin containing particles on the same side of the retardation film 12 as and the transparent conductive layer 16.

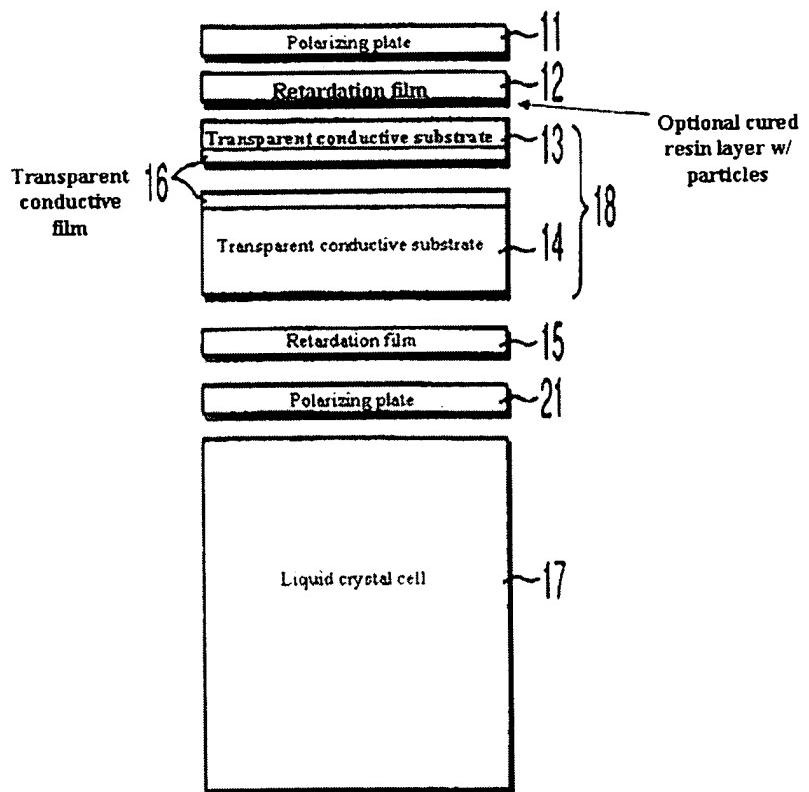
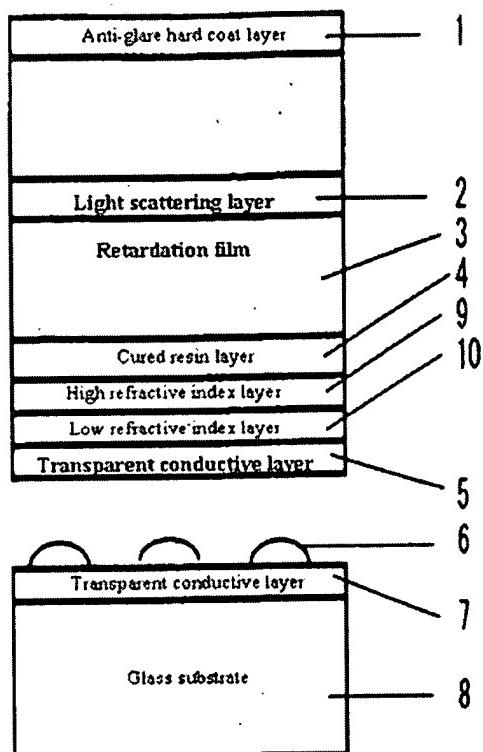
Below-left, Applicant’s FIG. 2 (reference characters labeled from specification) is contrasted with Fujii FIG. 5. Applicant’s FIG. 2 in no way is intended to limit the scope of claim 12, but is only given to aid in understating the structural relationships between the various layers recited in claim 12. It is clear, when contrasting that which is disclosed by Fujii with that which is recited in claim 12, Fujii clearly fails to disclose:

"a film made of a polymer with a photoelastic constant of no greater than $70 \times 10^{-12} \text{ Pa}^{-1}$ (polymer film A),

a light-scattering layer with a haze value in the range of 0.2-1.4% formed directly on one side thereof, and

a transparent conductive layer formed on the other side thereof, wherein the laminate exhibits a $\lambda/4$ retardation[.]"

Fig. 2



APPLICANT

FUJII

Because even the combination of Mikoshiba '458, Yamaoka, and Fujii would still fail to yield the claimed invention, a *prima facie* case of obviousness has not been presented regarding claim 12. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (To establish *prima facie*

obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.); *see also* MPEP 2143.03.

Further, in failing to consider the structural relationships of the films of the laminate of claim 12, the Office Action fails to consider laminate recited in Applicant's claim 12 as a whole and disregards express features. When evaluating the scope of a claim, every limitation in the claim must be considered. *In re Ochiai*, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995). Further, the claimed invention may not be dissected into discrete elements to be analyzed in isolation, but must be considered as a whole. *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983).

Because the Office Action fails to consider claim 12 as a whole, fails to consider all claim limitations, and attempts to analyze elements of claim 12 in isolation, a *prima facie* case of obviousness has not been presented regarding claim 12.

For reasons similar to those provided regarding claim 12, independent claim 20 is similarly not disclosed or suggested by the relied-upon references. Dependent claims 21-40 distinct for their incorporation of these features as well as for their separately recited patentably distinct features.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 12 and 20-40 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Mikoshiba '458, Yamaoka, and Fujii.

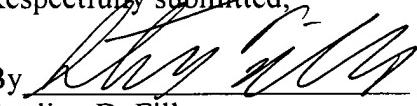
CONCLUSION

This response is believed to be a complete response to the Office Action. However, Applicant reserves the right to set forth further arguments supporting the patentability of the claims, including the separate patentability of the dependent claims not explicitly addressed herein, in future papers. Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicant expressly does not acquiesce to the taking of Official Notice, and respectfully requests that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03.

Applicants believe no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. TEI-0132 from which the undersigned is authorized to draw.

Dated: February 25, 2009

Respectfully submitted,

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